REMARKS

This amendment responds to the final Office Action mailed on November 26, 2007 and further to the Advisory Action mailed on January 29, 2008. The shortened statutory period for response is set to expire on February 26, 2007. Accordingly, applicants respectfully submit that this response is being timely filed.

Amendments Restore Claims to their Prior Form

Applicants initially note that the above amendments to independent claims 1 and 14 have been made to restore the claims to their form that has already been considered by the U.S. Patent and Trademark Office in the present application. Independent claims 1 and 14 now appear with the same limitations that were searched and considered by U.S. Patent and Trademark Office when issuing the Office Action dated June 26, 2007. Thus, these amendments do not raise any new issues nor require any further consideration and/or search, in that these features were already searched and considered and an Office Action has already been issued on June 26, 2007 on these very issues. These amendments are being submitted to place the application in better form for allowance and/or appeal by simplifying the issues on appeal to those issues that have already been considered and acted upon by the U.S. Patent and Trademark Office. It is requested that these amendments rightfully be re-entered in the present application.

Applicants note that the features of independent claims 1 and 14 added by the above amendments were present in these claims when applicants submitted their claim amendments with their Request for Continued Examination (RCE) filed on April 3, 2007. As stated above, these same features were searched and considered and were the subject of the Office Action dated June 26, 2007. Upon indication from Examiner Vig in the Examiner Interview conducted on August 28, 2007 that independent claims 1 and 14 would be allowable if rewritten as reflected in the Amendment filed on September 25, 2007, independent claims 1 and 14 were amended according to the Examiner's suggestions to advance their prosecution. However, rather than allow independent claims 1 and 14, a final Office Action was issued on November 26, 2007

rejecting claims 1 and 14 on substantially the same prior art grounds and also on new grounds under 35 U.S.C. § 112. Thus, independent claims 1 and 14 are being amended above to restore the same features already considered by the U.S. Patent and Trademark Office in order to, among other things, place the claims in better form for allowance and/or appeal by removing the 35 U.S.C. § 112 issues with respect to these claims.

Examiner Interview Summary

Applicants would like to express their appreciation of the courtesy extended by Examiner Vig in conducting a telephonic interview with applicants' undersigned attorney on February 11, 2008. During the telephonic interview, the reasons for January 29, 2008 Advisory Action and the sufficiency of the rejections in the November 26, 2007 Office Action were discussed in which applicants continued to assert that the pending claims were patentable over the cited prior art of record. In particular, applicants stressed key differneces between the present claims and the cited *IBM* and *Akimoto* references. Since no agreement could be reached during the telephonic interview, applicants were encouraged by Examiner Vig to submit their arguments distinguishing the present claims over the prior art (as set forth below) in a separate Pre-Appeal Brief Request for Review. Applicants have submitted the present amendments in order to, among other things, place the claims in better form for allowance and/or appeal.

Summary of Pending Claims

Claims 1-10, 14-20 and 22-24 are pending in the present application, and applicants believe these claims are in proper condition for allowance for the reasons set forth below. In summary, the combination of cited prior art fails to teach or suggest a number of features recited in the these claims:

1) a transaction service server determining a preferred communication format for each of the recipient parties for an electronic business transaction document received over a computer network by interpreting communication format indicators associated with each of the plurality of recipient parties contained in the electronic business transaction

document received in an electronic file format at the transaction service server (as recited in independent claims 1 and 14 as amended above),

2) the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format (as recited in independent claims 1 and 14 as amended above), and

3) an electronic business transaction document containing address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is automatically retrieved from an electronic address book stored at a client computer (as recited in independent claim 19).

Claim Rejections - 35 U.S.C. § 112

Claims 1-10 and 14-18 are rejected under 35 U.S.C. § 112, second paragraph, as being vague and indefinite, because it is asserted in the Office Action that it is not clear from these claims how the transaction service server will determine the preferred communication format for each of the recipient parties of the business transaction. By the above amendments, independent claims 1 and 14 have been amended back to their previous form that had already been considered by the U.S. Patent and Trademark Office reciting that the electronic business transaction document includes "a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format." Independent claims 1 and 14 further recite that "software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction."

In the previous Office Action dated June 26, 2007 that considered these same features, no rejections under 35 U.S.C. § 112 were set forth for independent claims 1 and 14 containing this

very same language. It is respectfully submitted that claims 1-10 and 14-18 now particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully request reconsideration and withdrawal of the § 112 rejection.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1, 2, 7-10, 14, 18-20 and 23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over IBM Corporation Product Facsimile Support/400 ("IBM") in view of U.S. Patent No. 6,424,426 issued to Henry ("Henry") and U.S. Patent No. 6,775,711 issued to Akimoto ("Akimoto"). Claims 3-6, 15-17, 22 and 24 were rejected under 35 U.S.C. U.S.C. § 103(a) as being obvious over IBM in view of Henry and Akimoto and further in view of NetGram.com ("NetGram"). Applicants traverse the Examiner's rejections for the following reasons.

The Cited Prior Art Fails to Teach or Suggest a Server Computer Interpretting a Preferred Communication Format of the Recipient Parties Indicated in the Business Transaction Document

Independent claims 1, 14 and 19 recite electronic business transaction service methods and software for conducting a business transaction over a computer network and sending an electronic business transaction document in a preferred communication format of each recipient party. The electronic business transaction document includes a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, wherein the electronic business transaction document is to be sent to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format. The transaction service server computer receives the electronic business transaction document over a computer network, interprets the preferred communication format indicators of each of the plurality of recipient parties of the business transaction, and sends the electronic business transaction document to the recipient parties in their interpretted preferred communication format.

The Combination of IBM, Henry & Akimoto Fails to Teach or Suggest Interpretting Preferred Communication Format Indicators

It is admitted in the Office Action that "*IBM* in view of *Henry* does not explicitly teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction." *See first full paragraph on page 5 of the Office Action.* Both the January 29, 2008 Advisory Action and the November 26, 2007 Office Action cite *Akimoto* to cure the deficiency of determining a preferred communication format for each of the plurality of recipient parties of the business transaction, where *Akimoto* is cited as teaching this feature.

However, *Akimoto* fails to teach or suggest determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction and then sending the business transaction document in the preferred communication format of a recipient party (where at least one recipient party receives the document in a computer communication format and at least one other recipient party receives it in a non-computer communication format). To the contrary, *Akimoto* is directed to an email communication system having a single communication format – namely, all communications occur according to a standard MIME email format. *See col. 5, lines 19-54 & col. 9, lines 44-47 of Akimoto.* There is no teaching or suggestion in *Akimoto* that transmissions to recipients can occur in any format other than standard email transfer protocol format (i.e., MIME).

The Office Action cites Akimoto's Figure 8 and the associated description as teaching a determination of preferred communication formats of recipient parties. *See* Page 5, Final Office Action dated November 26, 2007 and Continuation Sheet (PTO-303) attached to the Advisory Action dated January 29, 2008. Rather than describing preferred communication formats (i.e., computer communication format or non-computer communication format) of recipient parties, Figure 8 and its related description in *Akimoto* discuss how various identification characters can be used to signify that certain processes be performed on the email that is being sent. The email communication system of *Akimoto* detects special characters "A" to "C" after the identifirfcation character "@" in the email address to determine that special processing associated with these

characters is executed. See *Akimoto*, col. 8, lines 30-35 (describing Figure 8). Figure 7 brings further understanding to *Akimoto*'s identification characters. Here, as identification characters, characters "A" to "C" are used in addition to "@" in order to determine processing respectively associated with these identification characters. When the identification "A" is added, signature processing is carried out. When the identification "B" is added, encryption processing is carried out. When the identification "C" is added, JPEG conversion is carried out. The JPEG conversion is herein referred to processing for converting the MH file to the JPEG file." See *Akimoto, col. 7, lines 25-35* (describing Figure 7).

However, as clearly shown at the bottom of the flow chart illustrated in Figure 8, regardless of which type of content processing has been indicated to be performed, all communications are ultimately transmitted in (step T15) in an email transmission protocol format where determinations are made in steps (T13) and (T14) to ensure that the recipient address is a suitable email format. *See Akimoto, col. 8, lines 60-65.* Instead of disclosing determining different communication formats as asserted in the Office Action, Figure 8 and the respective description of Figure 8 in *Akimoto* discuss how various identification characters are used to process the content of an email (e.g., signature or encryption processing) before the content is transmitted according to an email transfer protocol format, irregardless of the type of the content processing that was performed according to the identificatin characters. For example, see column 9, lines 44-47 of *Akimoto* which recites that the server only performs processing of the content (i.e., image data) according to the identification characters, but thereafter sends the processed image data in accordance with an e-mail transfer protocol. As such, *Akimoto* only discloses that a computer communication format (i.e., email transfer protocol) is used for all recipient parties.

It is respectfully submitted that the communication format remains unchanged in *Akimoto* (e.g., the communication format is always e-mail transfer protocol). As such, *Akimoto* fails to cure the deficiency of *IBM* and *Henry* admitted by the Examiner as failing to teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. In fact, just as *Akimoto*

discloses that all communications occur according to an email communication format, *IBM* also teaches that a single communication format be used for all communications, namely *IBM* teaches that industry standard CCITT Group 3 fax format be used. *See pages 4-5 of IBM.* As described in paragraph [0003] of the present specification, the use of such industry-wide standards for all communications is a limitation on business that the electronic transacton service system of the present application is designed to avoid.

To the contrary of the cited prior art , independent claims 1, 14 and 19 recite that transaction service server computer determines a preferred communication format for each of the plurality of recipient parties of the business transaction by interpreting communication format indicators in the electronic business transaction document itself. Independent claims 1, 14 and 19 further recite that it is determined whether the preferred format is either a computer communication format or a non-computer communication format, where the business transaction document is sent to the recipient in the preferred communication format. As such, the combination of *IBM, Henry* and *Akimoto* fails to teach or suggest all of the limitations of independent claims 1, 14 and 19. It is respectfully submitted that the obviousness rejection of independent claims 1 and 14 and their respective dependent claims cannot be maintained in view of the combination of *IBM*, *Henry* and *Akimoto*, and applicants submit that such claims are now in proper condiction for allowance.

Henry Fails to Disclose An Electronic Business Document Received By a Server Over a Computer Network

Independent claims 1, 14 and 19 of the present application recite that the electronic business transaction document is created on a client computer and is received by the transaction service server computer communicating with the client computer through a computer network. *Henry* is cited in the Office Action as teaching a business server capable of sending business documents in different formats. However, *Henry* does not teach a business management software program as disclosed in the present application nor does *Henry* disclose a server receiving an electronic business document over a computer network. Rather, Henry discloses technology related to the Internet fax service MongoNet (e.g., see www.mongonet.com) where

users manually fill out a form with email addresses and scan such form into a fax machine so that it is faxed to a fax server. The document is created by a user that fills in the email address on the form, not a computer program. The document is sent via facsimile to the fax server, not over a computer network in electronic form to the server. Thus, it is respectfully submitted that *Henry* fails to teach a transaction server computer that receives an electronic business transaction document created on a client computer that is received through a computer network, as recited in independent claims 1, 14 and 19.

Independent Claim 19 Further Recites Automatically Retrieving a Preferred Communication Format Indicator from an Electronic Address Book

It is initially noted that independent claim 19 recites an electronic business transaction service method in which the transaction service server computer interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction from the businsess transacton document. As it set forth above in distinguishing independent claims 1, 14 and 19 over such prior art in view of this feature, it is respectfully submitted that this feature is not taught or suggested by the combination of cited prior art.

Further, it respectfully submitted that independent claim 19 is additionally patentable over the cited prior art of record, because the cited prior art fails to teach or suggest an electronic business transaction document containing a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is generated at a client computer by automatically retrieving the preferred communication format indicator from an electronic address book stored at a client computer.

IBM is cited in the Office Action as disclosing an address book for retrieving a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, as recited in independent claim 19. Applicants respectfully traverse this characterization of *IBM* and submit that *IBM* actually teaches away from this feature.

IBM teaches that all communications must occur according to the industry standard CCITT Group 3 fax format, where *IBM* expressly indicates that it is an important characteristic

of its Facsimile Support/400 outbound process that all pages are converted to the CCITT Group 3 fax format. *See pages 4-5 of IBM.* As such, since all communications sent to recipient parties by the *IBM* device occur according to the industry standard CCITT Group 3 fax format, it would be contradictory to the teachings of *IBM* to store different communication format indicators in the *IBM* address book.

Applicants respectfully submit that *IBM* does not disclose the limitations that the Examiner has indicated to be taught in *IBM.* Namely, there is no disclosure in *IBM* of completing an electronic business transaction documents by retrieving preferred communication formats from an electronic address book on the client computer, as recited in independent claim 19. This feature is further not taught by the other cited prior art references. *Henry* discloses a system where users manually fill out a form with email addresses and scan such form into a fax machine so that it is faxed to a fax server, where there is no teaching or suggestion in *Henry* of retrieving preferred communication formats from an electronic address book on a client computer. Still further, *Akimoto* discloses an email communication system where all communications are sent according to an email transfer protocol format and there is again no teaching or suggestion of retrieving preferred communication formats from an electronic address book on a client computer.

Thus, it is respectfully submitted that the combination of *IBM*, *Henry* and *Akimoto* fails to teach or suggest creating an electronic business transaction document a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is generated at a client computer by automatically retrieving preferred communication format indicators from an electronic address book stored at a client computer. Thus, applicants submit that all of the limitations of independent claim 19 are not taught ot suggested by the combination of cited prior art, and it is respectfully submitted that independent claim 19 and its respective dependent claims are patentable over the cited prior art of record. Reconsideration is requested.

CONCLUSION

In each case, the pending rejections should be reconsidered in view of the amendments and remarks herein. Applicants believe that this case is in good condition for allowance, and a Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned at 949-732-6539, who will cooperate in any appropriate manner to advance prosecution. The Commissioner is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 070325-040017 is referred to when charging any payments or credits for this case.

Respectfully submitted,

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